



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,922	05/23/2001	Satoru Ueda	7217/64561	1620

530 7590 12/26/2006
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

EXAMINER

JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
----------	--------------

2134

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/26/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/863,922

Applicant(s)

UEDA, SATORU

Examiner

David Y. Jung

Art Unit

2134

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

CLAIMS PRESENTED

Claims 14-22 are presented.

Response to Arguments

Applicant's arguments are given in the Remarks section at pages 5-7.

Applicant's arguments have been fully considered but they are not persuasive.

At pages 5-7, Applicant argued that Mullor would teach away from a combination with Asai because "non-volatile memory of computer" as mentioned in Mullor would teach away from the type of storage such as CD-ROM. The Patent Office disagrees because a non-volatile memory of a computer is often actuated as a CD-ROM. Thus, the Office must conclude, at this time, that Applicant's arguments have been insufficiently persuasive.

CLAIM REJECTIONS

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mullor and Asai (both cited in the previous Office Actions).

Regarding claim 14, Mullor teaches all but "portable storage medium." See Col 5, Line 45 - Col 6, Line 3, 1 which discusses the restricting of use. Note that the very title of Mullor states its relation to license limitation. See also column 1, lines 53-58; column 2, lines 48-59; column 4, lines 19-24.

Asai teaches "portable storage medium" for the motivation of distributing software. See Fig 1 , Elements 14 and 16b

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Mullor and Asai for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claims 15-17, these features are well known in the art for the purposes of distribution and security.

Regarding claim 18, Mullor teaches all but "storage medium" being "portable." See Col 5, Line 45 - Col 6, Line 3, 1 which discusses the restricting of use.

Asai teaches "storage medium" being "portable" for the motivation of distributing software. See Fig 1 , Elements 14 and 16b

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Mullor and Asai for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claim 19, these features are well known in the art for the purposes of distribution and security.

Regarding claim 20, Mullor teaches all but "portable storage medium." See Col 5, Line 45 - Col 6, Line 3, 1 which discusses the restricting of use.

Asai teaches "portable storage medium" for the motivation of distributing software. See Fig 1 , Elements 14 and 16b

Hence, it would have been obvious to those of ordinary skill in the art at the time of the claimed invention to modify the teachings of Mullor and Asai for the motivation noted in the previous paragraphs so as to teach the claimed invention.

Regarding claims 21-22, these features are well known in the art for the purposes of distribution and security.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 2134

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

Points of Contact

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(571) 273-8300, (for formal communications intended for entry)

Or:

(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

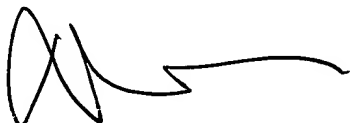
Art Unit: 2134

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Jacques Louis-Jacques whose telephone number is (571) 272-6962.

David Jung

Patent Examiner

12/19/06

A handwritten signature in black ink, consisting of a stylized 'D' followed by a series of loops and a long horizontal stroke.